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AUG 01 2006

OFFICE OF PETITIONS

In re Application of
Jiang, et al. : DECISION ON APPLICATION
Application No. 10/823,963 : FOR PATENT TERM
Filed: April 14, 2004 : ADJUSTMENT
Attorney Docket No.A369-CIP :
:

This is a decision on the "Application for Patent Term Adjustment under 37 CFR 1.705(b)" filed February 9, 2006, requesting that the Office reconsider the determination of Patent Term Adjustment (PTA) that accompanied the Notice of Allowance. Applicant requests that the initial determination of patent term adjustment be corrected from forty-four (44) days to seventy-three (73) days.

The application for patent term adjustment is GRANTED.

The Office has updated the PTA screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of mailing of the Notice of Allowance is seventy-three (73) days. A copy of the updated PAIR screen, showing the correct determination is enclosed.

BACKGROUND

On January 24, 2006, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) in the above-identified application. Applicant was advised that the patent term adjustment to date was 44 days.

In response, on February 9, 2006, applicant timely¹ filed the instant request for reconsideration of the patent term adjustment (PTA) with the payment of the fee set forth in 37 CFR 1.18(e). Applicants assert that the correct number of days of PTA at the time of the mailing of the Notice of Allowance was 73 days. Applicants further assert that the patent term adjustment should not have been reduced by 29 days, pursuant to 37 CFR 1.704(c). The record reflects that a non-final Office action was mailed on August 26, 2005, and that applicant filed a response on October 3, 2005, that contained only six pages. Applicant maintains that the first response filed on October 3, 2005, was incomplete because of a malfunction of applicants' facsimile machine, but that applicant filed a complete response on October 3, 2005, that was received by the PTO. The record reflects that the first incomplete response was made of record and a Notice of Non-Compliant Amendment was issued therefrom on October 11, 2005, notwithstanding the

¹ PALM records indicate that the issue fee payment was received on May 2, 2006.

transmission of a complete reply later on October 3, 2005. The amendment was filed again on November 1, 2005, in response to the Notice of Non-Compliant Amendment. Applicant asserts that the reduction of the patent term for applicant delay is not warranted because the amendment correcting the omission was filed October 3, 2005.

The record supports a conclusion that the patent issuing from this application is not subject to a terminal disclaimer.

RELEVANT STATUTES AND REGULATIONS

37 CFR § 1.704(a) provides that:

The period of adjustment of the term of a patent under § 1.703(a) through (e) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application.

37 CFR § 1.704(c)(7) and (8) provide that:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to extent that the periods are not overlapping:

(7) Submission of a reply having an omission (§ 1.135(c)) in which case the period for adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed.

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

OPINION

Applicant's argument and evidence have been considered in light of the application history. It has been determined that the initial period of adjustment pursuant to § 1.702(a)(1) was incorrect. The record reflects that the non-final Office action was mailed on August 26, 2005, with an amendment being filed responsively on October 3, 2005. The amendment that was entered into the record only contained six pages and was later deemed to be incomplete. The evidence presented by the applicant demonstrates that a second amendment consisting of eleven

pages correcting the omission of the first amendment was also filed on October 3, 2005, although it was not entered into the record². It is noted that the amendment was filed again on November 1, 2005, in response to a Notice of Non-Compliant Amendment mailed October 11, 2005. The period for reduction of the patent term is zero (0) days because the omission in the first reply filed October 3, 2005, was corrected by a reply filed on the same day and the supplemental reply filed November 1, 2005, was expressly requested by the examiner.

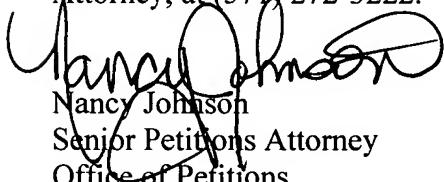
CONCLUSION

In view thereof, the petition is GRANTED.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Following revival of the application pursuant to 37 CFR 1.137(b)³, the application file will be forwarded to the Office of Patent Publications for timely issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and/ or reduction for applicant delay.

Telephone inquiries regarding this matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PAIR Screen

² It is noted that a copy of the Auto-Reply Facsimile Transmission sheet was filed with the petition demonstrating that an amendment consisting of eleven pages was successfully transmitted on October 3, 2005.

³ It is noted that the application is currently abandoned for failure to timely pay the issue fee. The petition under 37 CFR 1.137(b), filed May 2, 2006, is noted.

PALM INTRANET

PTA Calculations for Application: 10/823963

Application Filing Date:	<u>04/14/2004</u>	PTO Delay (PTO):	<u>73</u>
Issue Date of Patent:		Three Years:	<u>0</u>
Pre-Issue Petitions:	<u>0</u>	Applicant Delay (APPL):	<u>29</u>
Post-Issue Petitions:	<u>0</u>	Total PTA (days):	<u>73</u>
PTO Delay Adjustment:	<u>29</u>		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
33	07/27/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	29		
26	01/24/2006	MAIL NOTICE OF ALLOWANCE			
25	01/24/2006	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
24	01/23/2006	ISSUE REVISION COMPLETED			
23	01/23/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
22	01/23/2006	CASE DOCKETED TO EXAMINER IN GAU			
21	01/19/2006	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
20	01/23/2006	NOTICE OF ALLOWABILITY			
19	11/09/2005	DATE FORWARDED TO EXAMINER			
18	11/01/2005	RESPONSE AFTER NON-FINAL ACTION	29	15	
17	10/11/2005	MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT			
16	10/06/2005	DATE FORWARDED TO EXAMINER			
15.1	10/03/2005	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION			
15	10/03/2005	RESPONSE AFTER NON-FINAL ACTION			
14	08/26/2005	MAIL NON-FINAL REJECTION	73		-1
13	08/24/2005	NON-FINAL REJECTION			
12	08/23/2005	CASE DOCKETED TO EXAMINER IN GAU			
11	01/10/2005	MISCELLANEOUS INCOMING LETTER			
10	07/22/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
9	07/22/2004	CASE DOCKETED TO EXAMINER IN GAU			
8	06/24/2004	APPLICATION RETURN FROM OIPE			
7	06/24/2004	APPLICATION RETURN TO OIPE			

6	06/24/2004	APPLICATION DISPATCHED FROM OIPE			
5	06/25/2004	APPLICATION IS NOW COMPLETE			
4	05/17/2004	CLEARED BY OIPE CSR			
3	05/17/2004	CASE CLASSIFIED BY L&R			
2	04/23/2004	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	04/14/2004	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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